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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,127	01/03/2002	David J. Segelstein	2001-0168	8790

7590

08/25/2005

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EXAMINER

JEAN GILLES, JUDE

ART UNIT

PAPER NUMBER

2143

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/040,127

Applicant(s)

SEGELSTEIN, DAVID J.

Examiner

Jude J. Jean-Gilles

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01/03/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Action is in regards to the Reply received on 24 May, 2005.

Response to Amendment

1. This action is responsive to the application filed on May 24th, 2005. Claims 10 and 13 were amended. No new claims are newly added. Claim 12 has been cancelled. Claims 1-11 and 13-22 are pending. Claims 1-11 and 13-22 represent a method and apparatus for "providing auto-registration of an IP telephony end-point."

Response to Arguments

2. Applicant's arguments with respect to claims 1 and 20 have been carefully considered, but are not deemed fully persuasive. Applicant's arguments are deemed moot in view of the following new ground of rejection as explained here below, necessitated by Applicant substantial amendment (i.e., a method for providing auto-registration of an IP telephony end-point) to the claims which significantly affected the scope thereof.

The dependent claims stand rejected as articulated in the First Office Action and all objections not addressed in Applicant's response are herein reiterated.

Information Disclosure Statement

3. The references listed on the Information Disclosure Statement submitted on 01/03/2002 have been considered by the examiner (see attached PTO-1449A).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 1-7, 9-11, 13-19, and 21-22** are rejected under 35 U.S.C. 102(e) as being anticipated by Pezzutti et al (Pezzutti), U.S. Patent No. 6,760,762 B2.

Regarding **claim 1**, Pezzutti discloses a method for registering of an IP telephony end-point (fig. 1, items 18, 32, and 60), comprising the steps of:

installing an end-point on an IP telephony network (*column 15, lines 18-58*);
receiving, by said end-point, a default configuration (*column 15, lines 18-58*);
subscribing to desired service features by said end-point using said default configuration (*column 18, lines 3-59*); and

receiving, by said end-point, a configuration which supports said desired service features (*column 18, lines 3-59*).

Regarding **claim 2**, Pezzutti discloses the method of claim 1 wherein said step of installing further comprises revealing a MAC address of the end-point to other devices on said IP telephony network (*column 19, lines 62-67*).

Regarding **claim 3**, Pezzutti discloses the method of claim 1 wherein said step of using said default configuration further comprises the step of entering an identification of a customer (*column 14, lines 33-52*).

Regarding **claim 4**, Pezzutti discloses the method of claim 3 wherein said identification of said customer is selected from the group consisting of a key, a customer identification number, an account number and a customer address (*column 14, lines 33-67; column 15, lines 1-58*).

Regarding **claim 5**, Pezzutti discloses the method of claim 1 wherein prior to said step of receiving a default configuration, the identification of said end-point is unknown (*column 14, lines 14-62*).

Regarding **claim 6**, Pezzutti discloses the method of claim 1 wherein said default configuration allows a customer to use said end-point to communicate with a predetermined destination (*column 14, lines 33-67; column 15, lines 1-58*).

Regarding **claim 7**, Pezzutti discloses the method of claim 6 wherein said predetermined destination is a service center (*column 15, lines 36-58*).

Regarding **claim 9**, Pezzutti discloses the method of claim 1 wherein said step of installing is performed by an entity selected from the group consisting of a customer and a third-party installer (*column 4, lines 12-39; column 14, lines 14-61*).

Regarding **claim 10**, Pezzutti discloses a method for performing automatic registration of an IP telephony end-point (*fig. 1, items 18, 32, and 60, lines*) comprising the steps of:

performing a first-stage registration, wherein said first stage-registration provides service capable of allowing a customer to subscribe to a desired service, wherein said step of performing a first-stage registration includes the step of receiving a default configuration (*column 15, lines 18-58; column 18, lines 9-59*); and

performing a second-stage registration wherein said end-point is provided with the desired service (*column 18, lines 59*).

Regarding **claim 11**, Pezzutti discloses the method of claim 10 wherein said step of performing a first-stage registration includes the step of installing said end-point on an IP telephony network (*column 15, lines 36-58*).

Regarding **claim 13**, Pezzutti discloses the method of claim 10 wherein said step of performing a first-stage registration includes the step of using said default configuration to subscribe to the desired service (*column 15, lines 18-58*).

Regarding **claim 14**, Pezzutti discloses the method of claim 11 wherein said step of performing a first-stage registration includes the step of revealing a MAC address to other devices on said network (*column 19, lines 62-67*).

Regarding **claim 15**, Pezzutti discloses the method of claim 12 wherein said step of performing a first-stage registration includes the step of entering an identification of a customer (*column 14, lines 33-67; column 15, lines 1-58*).

Regarding **claim 16**, Pezzutti discloses the method of claim 15 wherein said step of entering an identification number of a customer enters an identification number selected from the group consisting of a key, a customer identification number, an account number and a customer address (*column 15, lines 1-58*).

Regarding **claim 17**, Pezzutti discloses the method of claim 12 wherein prior to said step of receiving a default configuration, the identification of said end-point is unknown (*column 14, lines 14-62*).

Regarding **claim 18**, Pezzutti discloses the method of claim 12 wherein said step of performing a first-stage registration includes the step of using said default configuration to communicate with a predetermined destination (*column 14, lines 33-67; column 15, lines 15, lines 1-58*).

Regarding **claim 19**, Pezzutti discloses the method of claim 18 wherein said predetermined destination comprises a service center (*column 15, lines 36-58*).

Regarding **claim 21**, Pezzutti discloses the method of claim 11 wherein said step of installing is performed by an entity selected from the group consisting of a customer and a third-party installer (*column 4, lines 12-39; column 14, lines 14-61*).

Regarding **claim 22**, Pezzutti discloses the method of claim 10 wherein said step of performing a second-stage registration includes the step of receiving a configuration which supports said desired service (*column 18, lines 3-59*).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 8 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Pezzutti in view of Wang et al. (Wang), U.S. Patent No. 6,636,505 B1.

Regarding **claims 8 and 20**, Pezzutti a method for registering an IP telephony end-point with a service center destination (*column 15, lines 36-58*), but does not specifically disclose said predetermined destination as a server.

In the same field of endeavor, Wang discloses a (subscriber's customer premises that is connected by a communication channel to a server in a central office network provider) [*see Wang, column 5, lines 20-29; fig. 2, item 130*].

Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Wang's teachings of a method to use a server in a service center as a predetermined destination, with the teachings of Pezzulli, for the purpose of "*offering a valuable advantage of a simpler to design and manage, and reduce in time necessary to research and correct inaccuracies in collected data prior to storage*" as stated by Pezzutti in lines 5-11 of column 17. Thus, Wang also provides motivation to

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combine by stating a need to also provide to the network with "*the high speed downstream channel from the server, used to convey information to the subscriber...*" [see Wang, column 3, lines 8-20]. By this rationale **claims 8 and 20** are rejected.

Response to Arguments

8. Applicant's Request for Reconsideration filed on May 24th, 2005 has been carefully considered but is not deemed fully persuasive. However, because there exists the likelihood of future presentation of this argument, the Examiner thinks that it is prudent to address Applicants' main points of contention.

A. The Pezzutti patent fails to disclose or suggest, the alleged novel concept of registering of an IP telephony end-point, where the endpoint receives a default configuration, with respect to independent **claims 1, and 10**.

B. Applicant contends that independent **claims 2-7, 9, 11, 13-19, and 21-22** which recite additional limitations to claims 1 and 10 are patentable and are not anticipated by Pezzutti.

C. Applicant contends that Pezzutti and Wang (either singly or in combination) fails to teach or suggest the alleged novel concept of registering of an IP telephony end-point, where the endpoint receives a default configuration.

9. As to "Point A" it is the position of the Examiner that Pezzutti in detail teaches the limitations of the above-mentioned claims. However, in view of Applicant's

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remarks, stating that Pezzutti only teaches an intelligent network for providing network access services where unregistered network access units can be discovered, the Examiner contends that Applicant's arguments are deemed moot in view of the following new grounds of rejection. Pezzutti teaches in column 18 lines 9-37 (see gig. 1, an installer that performs NAU automatic installation and or repair activity and service.

As to "Point B", it is also the Examiner's position that applicant traversal with respect to the independent **claims 2-7, 9, 11, 13-19, and 21-22**, are unpersuasive for the reasons mentioned above [see rejections of claims 2-7, 9, 11, 13-19, and 21-22].

As to "Point C", it is also the Examiner's position that applicant traversal with respect to the obvious rejection of claims 8 and 20, are unpersuasive for the reasons mentioned above [see rejections of claims 8 and 20].

Furthermore, **Patent Number 6,300,946 B1, by Lincke et al** teaches all the limitations of the claimed invention and applicant's traversals are also moot in view of this invention.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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11. Any inquiry concerning this communication or earlier communications from examiner should be directed to Jude Jean-Gilles whose telephone number is (571) 272-3914. The examiner can normally be reached on Monday-Thursday and every other Friday from 8:00 AM to 5:30 PM.

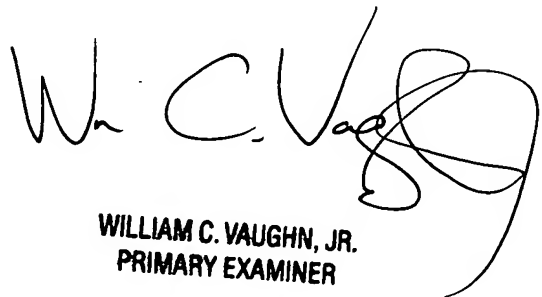
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-9000.

Jude Jean-Gilles

Patent Examiner

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WILLIAM C. VAUGHN, JR.
PRIMARY EXAMINER

JJG

August 20, 2005

